

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUHIRO AKASAKA,
TATSUYA KAKUTA, KOHEI KOBAYASHI,
YAUSO MATSUDA and SHIGERU TOMITA

Appeal No. 95-2773
Application 07/937,953¹

HEARD: January 11, 1999

Before JOHN D. SMITH, PAK and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 5, which are all of the claims in the application.²

We have carefully considered the record before us, and based thereon, find that we cannot sustain any of the grounds of rejection of all of the appealed claims under 35 U.S.C. § 112, first paragraph, written description and enablement, and second paragraph, and under 35 U.S.C. § 103 as

¹ Application for patent filed September 1, 1992.

² See specification, page 9, and the amendment of December 16, 1993 (Paper No. 7).

being unpatentable over Japanese Kokai Patent Publication No. 60-83908, published May 13, 1985,³ or published European Patent Application 0 311 186, published April 4, 1989, in view of Japanese Kokai Patent Publication No. 2-125214, published May 14, 1990⁴ (answer, pages 3-6).⁵

The grounds of rejection under 35 U.S.C. § 112 involve the claim language “an outermost layer comprising a UV-curing resin having” the specified Young’s modulus and “change of cure shrinkage degree.”⁶ We first consider the examiner’s contentions with respect to the meaning of the claim term “resin”, which issue of definiteness we must resolve before considering the issues raised by the examiner under § 112, first paragraph. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). We have reviewed the term “resin” in light of appealed claim 1 as a whole as well as in view of the specification as to whether this claim in fact sets out and circumscribes a particular area with a reasonable degree of precision and particularity as required by the statute. *Id.* We find that the specification sets forth the phrase “any resin which has the above [Young’s modulus and “change of cure shrinkage degree”] properties” (page 3, lines 15-16) such that one skilled in the art would have read the criticized term “resin” in claim 1 as inclusive of polymers and copolymers. Accordingly, we reverse the ground of rejection under § 112, second paragraph, because we conclude that one skilled in this art would reasonably understand from the specification what is claimed by the use of the term “resin.”

Turning now to the ground of rejection under § 112, first paragraph, enablement, the examiner has the burden of providing a reasonable explanation, supported by the record as a whole, why the assertions as to the scope of objective enablement set forth in the specification with respect to the “UV-curing resin” is in doubt, including reasons why the description of the invention in the specification would

³ We refer herein to the translation of Japanese Kokai Patent Publication No. 60-83908 prepared for the PTO by FLS, Inc., in May, 1995. A copy of this translation is attached to our decision.

⁴ We refer herein to the translation of Japanese Kokai Patent Publication No. 2-125214 prepared by the PTO on April 27, 1995. A copy of this translation is attached to our decision.

⁵ The examiner has withdrawn the ground of rejection of appealed claim 5 under 35 U.S.C. § 112, fourth paragraph (answer, page 7).

⁶ The original claim and specification specifies the unit for the Young’s modulus as kg/mm² units while appealed claim 1 as it stands of record and copied in the brief specifies the unit as “kg/mm₂”. We will use the former unit herein.

not have enabled one of ordinary skill in this art to practice the claimed invention without undue experimentation, except as set forth at “page 2, lines 25-26 of the specification.” *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); *In re Geerdes*, 491 F.2d 1260, 1264, 180 USPQ 789, 793 (CCPA 1974); *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). The examiner has not explained why this disclosure along with the disclosure at page 4, line 25, to page 5, line 5, of the specification would not have enabled one of ordinary skill in this art to practice the claimed invention to the full extent of the scope of the appealed claims. Accordingly, we reverse this ground of rejection because the examiner has not carried the burden of establishing a *prima facie* case of non-enablement.

The remaining ground of rejection under § 112 involves the written description requirement of the first paragraph of this section. The examiner holds, without supporting scientific reasoning or evidence, that “the aspect of having the outer layer comprising a UV-curing resin constitutes new matter” (answer, pages 4 and 7) which is a rejection based on the written description requirement of § 112, first paragraph. *See, generally, Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 99 (CCPA 1976). In order to make out a *prima facie* case of failure of the *claims* to comply with this section of the statute, the examiner must set forth “evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996), quoting *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. We construe appealed claim 1 to require that an outermost layer comprises *at least* a UV-curing resin which has the specified characteristics based on Young’s modulus. *Exxon Chemical Patents Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995) (“The claimed composition is defined as comprising - meaning containing at least - five specific ingredients.”). The record shows that appellants have substituted the term “comprising” for the phrase “is made of” and argue that one skilled in this art would have recognized that other ingredients would be used in making a layer containing at least the specified UV-curing resin. (e.g., principal brief, pages 6-7; reply brief, pages 1-2). The examiner has not rebutted appellants’ contention and, indeed, has done no more than allege that “the specification and the claims” do not support “comprising.” Accordingly, we

reverse this ground of rejection because the examiner has not carried the burden of establishing a *prima facie* case that the disclosure does not provide a description of the invention defined by the claims to one skilled in this art.

We will also not sustain the grounds of rejection of the appealed claims under § 103. It is well settled that in order to establish a *prima facie* case of obviousness, “[b]oth the suggestion and the reasonable expectation of success must be found in the prior art and not in applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Thus, a *prima facie* case of obviousness is established by showing that some objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention without recourse to the teachings in appellants’ disclosure. *See generally In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring). The examiner has maintained that Japanese Kokai Patent Publication No. 2-125214 “shows that it is [sic, was] known in the art to have resin coatings with modulus range encompasses [sic] those as claimed” (answer, page 5) and has not rebutted appellants’ argument (answer, pages 5, 6 and 8) that the disclosure of a “layer made of resin with bending elasticity 50-500 kg/cm²” in this reference (e.g., page 1; emphasis ours) is indeed “a Young’s modulus of elasticity of . . . 0.5 to 5 kg/mm²” (principal brief, page 10; reply brief, page 2; emphasis ours). We find no reference of record which discloses a UV-curing resin which has either of the characteristics based on Young’s modulus specified in appealed claim 1. Thus, we agree with appellants (reply brief, page 3) that the record before us supports the inference that the examiner has relied on information gleaned from appellants’ disclosure in formulating this ground of rejection. Accordingly, we reverse this ground of rejection because the examiner has not carried the burden of establishing a *prima facie* case of obviousness.

The examiner's decision is reversed.

Reversed

JOHN D. SMITH
Administrative Patent Judge

CHUNG K. PAK
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

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Cushman, Darby & Cushman
Ninth Floor
1100 New York Ave., N.W.
Washington, D.C. 20005-3918